



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,171	12/01/2000	Brent R. Constantz	CORA-007CIP	3702

24353 7590 08/27/2002

BOZICEVIC, FIELD & FRANCIS LLP
200 MIDDLEFIELD RD
SUITE 200
MENLO PARK, CA 94025

EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 08/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,171

Applicant(s)

CONSTANTZ, BRENT R.

Examiner

Jennifer Kim

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's arguments filed February 25, 2002 have been fully considered but they are not persuasive.

Applicant's arguments are:

1. The Examiner has cited no case law or MPEP section to support the position that the recited instructional element is not deemed to hold any patentable weight.
2. In the present case, the instructions are a separate and important element of the claimed kit because they tell how to use the other components of the kit.
3. The courts treat instruction for use, e.g., in the form of printed matter, as a separate element to be accorded patentable weight just like any other recited element; In re Gulack, 217 U.S.P.Q 401 (1983) and the In re Gulack are the situations where the printed matter is not functionally related to the other elements of the claim therefore the printed matter do not carry patentable weight.
4. The In re Miller, 57, C.C.P.A. 809, 418F.2d 1392, 164 U.S.P.Q. (BNA) 46, the court found that the printed material was functionally related to the other elements of the claim because it told how to use the other elements of the claim.

However, in the instant case, the "Kit" claims are drawn to an old composition which comprises the instructions (intended use). The intended use lacks a function relationship because the instructions (intended use) ~~do~~ not physically or chemically affect the chemical nature within the article of manufacture, and furthermore, the skilled artisan can still use the old composition of the kit for other purposes. Further, In re Miller, 164 U.S.P.Q. 46 (CCPA 1969) and In re Gulak, 217 (CA FC)217 USPQ 401 relate to a mathematical device and to a measuring

Art Unit: 1617

cup respectively. In each of these cases, the printed matter is considered a patentable distinction because the function of the device depends upon the printed matter itself which is a part of the substrate; without the printed indicia or numbers, the substrates lose their function. Such is not the case with the instantly claimed articles. The "Kit" claimed articles remain fully functional absent the instructions for use.

It is further noted that the written material in the instructions is not considered to be within the statutory classes and does not carry patentable weight. See MPEP 706.03(a).

Therefore the old composition which are comprised within the claimed "Kit" are unpatentable over the prior art, because they function equally effectively with or without the instructions (intended use) and accordingly no functional relationship exists between the instructions for use and the composition. Thus the claims are addressed as being drawn to a "Kit" comprising an old composition, the instructions of the "Kit" bear no patentable weight with regard to 102 rejections.

In view of the above Office Action of 12/4/2001 is deemed proper and asserted with full force and effect hereby repeated to obviate applicant's claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

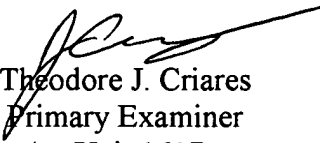
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 703-308-2232. The examiner can normally be reached on Monday through Friday 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Application/Control Number: 09/728,171
Art Unit: 1617

Page 5



Theodore J. Criares
Primary Examiner
Art Unit 1617

jmk
August 16, 2002